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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,572	09/04/2003	Mark Dane	H0644-700719	6428
37462 7590 03/11/2009 LOWRIE, LANDO & ANASTAS, LLP ONE MAIN STREET, SUITE 1100 CAMBRIDGE, MA 02142				
EXAMINER McCORMICK, GABRIELLE A				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
03/11/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@ll-a.com  
gengelso@ll-a.com

### Office Action Summary

**Application No.**

10/655,572

**Applicant(s)**

DANE ET AL.

**Examiner**

Gabrielle McCormick

**Art Unit**

3629

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 9/4/2003 and 4/01/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. This action is in reply to the Request for Continued Examination filed on February 2, 2009.
2. Claims 1 and 12 have been amended.
3. Claims 1-5 and 7-16 are currently pending and have been examined.

### ***Continued Examination Under 37 CFR 1.114***

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 17, 2008 has been entered.

### ***Drawings***

5. The drawings are objected to because they contain handwritten annotations. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR

1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-5 and 7-16 are rejected as being directed to non-statutory subject matter. Claims 1 and 12 are method claims that recite process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. (See Flook, 437 U.S. at 590).
8. Claim 1 recites that components are stored in a database. This recitation of the database structure does not rise to the standard of imposing meaningful limits on the claim's scope to impart patent-eligibility. Additionally, the use of the database is insignificant extra-solution activity.
9. Claim 12 does not recite the use of any machine implementation, rather, it recites method steps that can be implemented by a human being. The limitation of receiving feedback in real-time does not inherently require machine implementation.

10. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claims 1 and 12 fail that test and are therefore rejected under 35 USC 101.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 1-5 and 7-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et al. (US Pub. No. 2002/0069080 hereinafter referred to as "Roy") in view of Almog et al. (US Pub. No. 2002/0002479, hereinafter referred to as "Almog").
13. Roy discloses a web based system for cataloging, inventorying, selecting, measuring, valuing and matching "Intellectual Capital Skills" using networked computers and where the data is stored in a relational database. The system stores "Intellectual Capital codes" that are used to create a job description. (P [0038]). The system is accessible to various users, including clients (employers) and recruiters (i.e., a requirements specialist. Note: The term "recruiter" is understood to be descriptive of the field of employment that specializes in matching candidates and positions, therefore, a recruiter is a requirements specialist). (P [0128]). This provides the teaching that either a client or a recruiter may determine, view, receive, develop or create any part of the invention.
14. **Claim 1:** Roy discloses
- *developing a first job description, the first job description comprising a first set of components;* (P [0042] and Fig. 3(a))
  - *storing the first set of components in a database;* (P [0039])

- *creating a second job description having a second set of components, at least one of which is selected from the first set of components stored in the database.* (P [0038]: The "Intellectual Capital codes" can be used to create multiple job descriptions. Fig. 3(a) discloses a template in which multiple job descriptions would use the common components (fields of the template) for data entry.)
15. Roy further discloses that a client can edit the position skills by adding or deleting skills as needed for a position. (P[0134]). Though Roy does not explicitly disclose that a second job description is created based upon the first job description, it is obvious that in editing a first job description by adding or deleting skills, a second job description is created. Further, it is obvious to use a previous job description when creating a new one by editing the former. Roy would be motivated to do so to build on its system of providing uniform and consistent terminology that allows for an accurate and systematic search and comparison of candidate skills. (P[0007]).
  16. Roy also provides the motivation to create a second, edited job description in response to the matching results. It is obvious to create a revised job description in order to increase or decrease a pool of suitable applicants. For example, if the first job description results in a small pool of applicants, by editing the description to alter the requirements, the pool can be increased.
  17. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included creating a second job description based on the first, in the system of Roy for the motivation of efficiently creating job descriptions that use consistent terminology that aids in matching and to allow control over the size of a pool of applicants through changing the skill requirements of a first description to create a second one.
  18. Roy does not disclose that the second job description corresponds to a second job opening.
  19. Almog, however, discloses in formulating requirements for a job, the server suggests requirements for the position based on previous job openings posted by that employer. (P[0111]). Thus, the second posting and description that is created is based on the first job description from the previous job opening that was posted.

20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included basing the description for a second job opening on a first job description, as disclosed by Almog, in the system of Roy for the motivation of providing an effective and efficient means of creating job postings. Roy discloses that position information can be edited (P[0134]). It is old and well known to use an existing document as a template for a new one because it saves time. It is obvious to base a new job description on an old one. Examples of job posting information that would be consistent from one job posting to the next are the employer contact information. At the very least, one would be motivated to use a prior description as a starting point in order to reduce typographical errors.
21. **Claim 2:** Roy discloses determining the first set of components (P [0035]) and a requirements specialist (P[0128]: a recruiter).
22. **Claim 3:** Roy discloses selecting an Intellectual Capital code (P [0038]: position requirements are created) and displaying to a client (Fig. 3(a) is a screen shot that would be displayed to a client accessing through the system illustrated in Fig. 1).
23. **Claim 4:** Roy discloses storing in a relational database. (P [0039]).
24. **Claims 5, 7 and 9:** Roy discloses displaying the selection to a client and a recruiter using a computer system. (Fig. 3(a) is a screen shot that would be displayed to a client and a recruiter accessing through the system illustrated in Fig. 1).
25. **Claim 8:** Roy discloses a recruiter interacting with a client. (P [0134]).
26. **Claims 10 and 11:** Roy discloses an educational requirement and a task (skill). (P [0053]).
27. **Claims 12-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et al. (US Pub. No. 2002/0069080 hereinafter referred to as "Roy") in view of Danielson et al. (US Pat. No. 6,993,723, hereinafter referred to as "Danielson").
28. **Claim 12:** Roy discloses a requirements specialist (P[0128]: a recruiter) receiving hiring needs and determining a job description. (P [0042]: the job description is created using the menu of

skills required for the submitted job position). Roy further discloses that the client provides feedback on the job description (P[0134]: the client has the ability to edit the position skills) and that the recruiter modifies the job description (P[0135]: recruiter can enter/update and perform any of the tasks described above (i.e., those described in P[0134]) (P[0135])). P[0145] discloses that the recruiter has control over client entries, thus, the recruiter has the ability to edit the position description information. As the system is implemented over the Internet (P[0119]), the editing by the client is performed in real-time.

29. Roy does not disclose a connection between the requirements specialist and the feedback.
30. Danielson, however, discloses a collaboration system using groupware that allows for real-time data conferencing and group document handling. (C4; L49-67). This provides the ability to instantly share knowledge and work together. (C6; L47-50). Real-time user users are implemented via a chat window (C13; L55-56) and a message window (C14; L20-22).
31. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included a real-time collaboration tool, as disclosed by Danielson, in the system of Roy for the motivation of enabling efficient and effective collaboration and communication in work session between two or more people independent of time and place. (Danielson; C4; L31-34). The combination of the collaboration tool with Roy would provide a means for real-time interaction between the recruiter and client. As Roy has disclosed, the client can provide feedback, as evidenced by the editing of the position information (P[0134]). Roy also discloses that the recruiter preferably controls the client's entries (P[0145]). It is old and well known that a purchaser of a service (the client) interacts with the supplier of the service (the recruiter) to ensure that the client's needs are being met, therefore, it is obvious for the client and the recruiter of Roy to collaborate to ensure the client is satisfied with the recruiter's services.
32. **Claims 13 and 14:** Roy discloses displaying job descriptions to a client and a recruiter. (Fig. 3(a) is a screen shot that would be displayed to a client and a recruiter accessing through the system illustrated in Fig. 1).



33. **Claim 15:** Roy discloses storing in a database (P [0039]) and selecting codes from the database. (P [0038]).
34. **Claim 16:** Roy discloses an educational requirement and a task (skill) (P [0053]) where the skills are selected from a database (P [0038]).

### ***Response to Arguments***

35. Applicant's arguments with respect to claims 1 and 12 have been considered but are moot in view of the new ground(s) of rejection as detailed above.
36. Though the Examiner has applied art to claim 12, the Examiner notes that a meeting or phone call between the client and the recruiter would provide the real-time feedback.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3629

/JOHN G WEISS/  
Supervisory Patent Examiner, Art Unit 3629